

### **REMARKS**

Claims 1-19, 43-47, and 57-76 are currently pending in the subject application and are presently under consideration. A copy of the current claims is provided at pp. 2-7 for convenient reference. No amendments have been made thereto.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

#### **I. Rejection of Claims 43-47, 57-69, and 74-76 Under 35 U.S.C. §112**

Claims 43-47, 57-69, and 74-76 stand rejected under 35 U.S.C. §112, first paragraph, as failing to disclose the best mode. This rejection should be withdrawn for at least the following reasons. The specification sets forth the best mode contemplated by the inventor of carrying out his invention.

Determining compliance with the best mode requirement requires a two-prong inquiry. *First, it must be determined whether, at the time the application was filed, the inventor possessed a best mode for practicing the invention.* This is a subjective inquiry which focuses on the inventor's state of mind at the time of filing. Second, if the inventor did possess a best mode, it must be determined whether the written description disclosed the best mode such that a person skilled in the art could practice it. This is an objective inquiry, focusing on the scope of the claimed invention and the level of skill in the art. *Eli Lilly & Co. v. Barr Laboratories Inc.*, 251 F.3d 955, 963, 58 USPQ2d 1865, 1874 (Fed. Cir. 2001).

At page 2 of the Advisory Action (dated March 13, 2008), the Examiner construes the claims as a software application and substantially argues that because no software instructions/code are detailed in the specification, the best mode requirement is not met. In *Chemcast Corp. v. Arco Industries*, 913 F.2d 923, 16 USPQ2d 1033 (Fed. Cir. 1990), the court held that the proper test for satisfying the best mode requirement has two parts. First, it must be determined whether, at the time the application was filed, the inventor knew of a mode of practicing the claimed invention that the inventor considered to be better than any other. Such an inquiry is subjective because it focuses on the inventor's state of mind. (*See Id.*) *Unless the Examiner has evidence* that at the time the application was filed the inventor considered one

mode to be better than any others, there is no reason to address the second component, and the best mode requirement *is presumed to be met*. (See *Id.*).

Here, the Examiner has provided no evidence to suggest the best mode requirement has not been met. Accordingly, unless the Examiner presents some evidence that, at the time the subject application was filed, the inventor considered one mode to be better than any other, this rejection must be withdrawn. Moreover, The Examiner is to assume the best mode is disclosed unless there is evidence to the contrary. (See MPEP §2165.03) (“The examiner should assume that the best mode is disclosed in the application, unless evidence is presented that is inconsistent with that assumption. ***It is extremely rare that a best mode rejection properly would be made in ex parte prosecution.*** The information that is necessary to form the basis for a rejection based on the failure to set forth the best mode is rarely accessible to the examiner, but is generally uncovered during discovery procedures in interference, litigation, or other *inter partes* proceedings.” Because the Examiner provides no evidence that the inventor at the time of filing considered one mode to be better than all others, this rejection must be withdrawn.

Still further yet, the Examiner should note that it has been long held that where software is employed, specific source code or program listings are not generally required to satisfy the best mode requirement.

As a general rule, where software constitutes part of a best mode for carrying out an invention, description of such a best mode is satisfied by disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions are disclosed. *Fornar Corp v. General Elec. Co.*, 107 F.3d 1543, 41 USPQ2d 1801, 1805 (Fed Cir. 1997).

Applicant’s specification sufficiently discloses functionality associated with each component and/or module such that a person of skill in the art can generate a program or code that performs the functions without undue experimentation.

## **II. Rejection of Claims 1-19, 43-47 and 57-76 Under 35 U.S.C. §103(a)**

Claims 1-19, 43-47 and 57-76 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pallakoff (US 6,269,343), in view of Shavit, *et al.* (US 4,799,756, hereinafter

referred to as “Shavit”). It is respectfully requested that this rejection be withdrawn for at least the following reasons. The cited reference fails to teach or suggest each and every feature of the subject invention as claimed

The claimed subject matter relates to a system that facilitates volume pricing. More specifically, the system can aggregate orders for a product as well as aggregating shipping for the orders. In particular, independent claims 1 (and similarly independent claim 43) recites, “an offers and orders component that receives and aggregates orders for a product from a plurality of buyers; and *a logistics component ... that determines a shipping price for the product for a subset of the plurality of buyers, the shipping price being determined based at least in part upon the subset of buyers sharing a shipping method.*” The references, alone or when combined, do not teach or suggest these novel features.

Rather, Pallakoff relates to electronic commerce and more particularly marketing products and services utilizing the Internet. Nowhere does Pallakoff disclose or suggest *a logistics component that determines a shipping price for the product ... the shipping price being determined based at least in part upon the subset of buyers sharing a shipping method* as set forth in the subject claims. Instead, Pallakoff discloses aggregating demand and providing demand based pricing. (See col. 1, ll. 53-55). Although Pallakoff discloses a shipping charge can be applied to a buyer’s credit card (see col. 8, ll. 41-47), the reference is silent regarding an offers and orders component structurally interrelated with *a logistics component that determines a shipping price*. In particular, the fact that Pallakoff can *apply* a shipping charge does not teach or suggest a necessary structural *component that determines* the shipping charge based upon some criteria. Furthermore, a shipping charge in Pallakoff is materially distinct from a shipping price of the subject claims because Pallakoff does not teach or suggest the shipping charge is *determined based at least in part upon the subset of buyers sharing a shipping method*. Rather, Pallakoff is silent as to how the applied shipping charge is derived and certainly does not disclose or teach specific criteria for deriving (or a component that derives) the shipping charge based upon buyers sharing a shipping method.

#### ***A. Lack of Prima Facie Obviousness***

At page 6 of the Final Office Action (dated December 21, 2007), the Examiner concedes these deficiencies, but incorrectly contends that Shavit and/or a “delivery lunch” hypothetical

may remedy the deficiencies with respect to Pallakoff. Applicant's representative respectfully disagrees. Regarding Shavit, the reference relates to a system for interactive online electronic communications and processing of business transactions between independent users. Specifically, Shavit discloses that *a supplier* who has scheduled a shipment of less than a truckload on a particular route, *may advertise* the available space on the system in order to share freight costs. (See col. 17, ll. 17-21). Hence, Shavit fails to teach or suggest, “*a logistics component that determines a shipping price for the product the shipping price being determined based at least in part upon the subset of buyers sharing a shipping method*” in at least three distinct ways.

First, Shavit discloses that freight costs can be shared, but nowhere teaches a logistics component that *determines a shipping price for the product*. That is, Shavit alludes to the concept of sharing freight costs, concurrent arrangement of shipping (see col. 11, ll. 14-18), as well as reservation and control of freight services (see col. 14, ll. 31-33), but makes no determination of the freight costs for a product. Second, Shavit expressly indicates *suppliers* sharing freight *costs*, whereas the instant claims recite *buyers* sharing a shipping *method*. Third, Shavit discloses that in order to effectuate freight costs sharing, a supplier *may advertise* the available space. In particular, a bulletin board component that supports *advertising* available space in order to share freight costs is materially distinct from *a logistics component that determines a shipping price ... based at least in part upon the subset of buyers sharing a shipping method*.

Furthermore, the “delivery lunch” hypothetical introduced by the Examiner at page 6 of the Final Office Action is materially deficient to read upon the instant claims. The Examiner analogizes a situation in which a Chinese restaurant receives a single order containing many different courses for employees in the same office. The Examiner suggests, in that situation, the shipping/delivery price would be cheaper than if each of the employees placed individual/independent orders. It is readily apparent that the “delivery lunch” sets forth a concept of sharing freight costs, much like Shavit, however, the mere concept of sharing freight costs is insufficient to render obvious the subject claims. In particular, the concept of sharing freight costs does not teach or suggest the structure of the subject claims such as *a logistics component that determines a shipping price for the product, e.g., from orders for the product received and aggregated by an offers and orders component*.

In addition to the above, the Examiner's analysis also fails with regard to Shavit and "delivery lunch" because the Examiner is not considering the claim as a whole. Rather, the Examiner expressly argues that the claimed subject matter "is merely a [sic] software to calculate a lowest price for customers including shipping prices determinations according to a USA zip-code" (see Final Office Action, pg. 7, ll. 2-4). Hence, the Examiner is treating the logistics component as no more than a software calculator that looks up zip codes and, pointedly, the Examiner *considers these features in a vacuum*, absent the features recited elsewhere in the claim. In particular, the Examiner fails to appreciate that an offers and orders component can receive and aggregate orders for a product from a plurality of buyers and, inherently, that a shipping method for the plurality of buyers has been determined. By isolating these features and addressing them only in piecemeal fashion, the Examiner effectively ignores distinguishing features. Rather than appreciating that orders for a product are aggregated in connection with the determination of a shipping price for the product...based at least in part upon the subset of buyers sharing a shipping method, the Examiner seeks only to show that orders can be aggregated (Pallakoff) and, entirely independently, that freight costs can be shared (Shavit or "delivery lunch").

The Examiner's analysis of Pallakoff, Shavit, and the combination of such lacks a number of features included in the claims when considered in their entirety. Among these are: (1) the inherent determination of the shipping method for the plurality of buyers; (2) the inherent determination that a subset of buyers are sharing a shipping method; and (3) a determination of the shipping price for a subset of buyers from aggregate orders. These aspects are simply overlooked or ignored by presuming that the logistics component is merely calculating shipping prices from point A to point B based upon zip codes. That is, the Examiner presumes all that needs to be done is to calculate a shipping price (even though none of the references actually disclose this aspect, which is in itself grounds for withdrawing this rejection) because the Examiner takes it as a given that the shipping method is always the same (e.g., the "delivery lunch" example) with respect to all buyers. Accordingly, for at least the foregoing reasons, the Examiner has failed to make a *prima facie* case for obviousness and this rejection should be withdrawn.

### ***B. Improper Combination of References***

In addition, “delivery lunch” is not properly combinable with either Pallakoff or Shavit because it would change the principle of operation and/or destroy the intended purpose in both cases. In particular, “delivery lunch” requires a single order/transaction from related actors (*i.e.*, employees at the same office). As such there is no need to “aggregate” orders, as the many courses are ordered as part of the same transaction. In contrast, Pallakoff is specifically directed toward aggregating orders, and both Shavit (*see* Abstract) and Pallakoff (*see* col. 1, ll. 45-48) expressly contemplate that the orders for a product come from independent buyers (*i.e.*, not from related actors). That is, “delivery lunch” ***requires*** that the actors be related, whereas both Pallakoff and Shavit expressly exclude this requirement. Hence, combining “delivery lunch” would destroy the intended purposes of both Pallakoff and Shavit, and is therefore not properly combinable with these references.

### ***C. Independent Claim 43 and Dependent Claims***

Furthermore, applicant’s representatives have noted a number of shortcomings with respect to the Examiner’s analysis in a Reply to Final Office Action (filed February 21, 2008) to which the Examiner has not addressed or provided any evidence that the Examiner has considered these comments. Applicant’s representatives respectfully request the Examiner consider these comments or withdraw the associated rejections as is statutorily required.

With reference to at least independent claim 43, the Examiner concedes at page 8 of the Final Office Action that Pallakoff does not disclose a memory coupled to the processor, the memory stores a first price schedule and a second price schedule, the first price schedule determines a first price for the product for at least one of the plurality of different buyers and the second price schedule determines a second price for the product for the other plurality of different buyers. However, the Examiner substantially argues that Pallakoff provides the necessary structural components to do so. As such, the Examiner’s analysis provided with the rejection of this claim relies on improper assumptions that very high level features disclosed in Pallakoff read upon very specific details recited in the subject claims. Applicant’s representative respectfully submits that the CAFC has held that a machine (*e.g.*, memory) programmed in a certain new and unobvious way is physically different from the machine without that program; its memory elements are differently arranged. The fact that these physical changes are invisible

to the eye should not tempt one to conclude that the machine has not been changed. *In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994). As such, the Examiner is not free to conjecture that Pallakoff reads on the claims merely because Pallakoff discloses a generic computer, generic memory, and/or some other generic physical component that is absent recited features of the claims.

Regarding at least claim 6, Pallakoff does not disclose or suggest ***a terms and conditions component that manages agreements between users of the system as to business terms and conditions***. The Examiner contends that such claimed aspects are disclosed by Pallakoff at col. 1, ll. 55-58 and col. 12, ll. 5-10. Applicant's representative respectfully disagrees with such a contention. In more detail, the cited passage at col. 1, ll. 55-58 relates to *conditional offers*. The cited passage at col. 12, ll. 5-10 establishes the definition of system operator and reads "The *term* 'system operator' as used herein does not necessarily refer to an individual. The *term* refers to..." While Pallakoff uses the words "term" and "conditional" in its specification, the cited passages clearly do not relate to a terms and conditions component.

Referring to at least claims 2, 14, 15, 17, 18, 73, and 76, the Examiner argues substantially that it is old and well-known to provide for certain features not recited in the references. In particular, it is old and well-known to comprise a product catalogue (*see* Final Office Action, pg. 11); it is old and well-known that customers' historical data/profiles have been widely used for selling products (*e.g.*, a Circuit City store example and a Best Buy example at page 12 of the Final Office Action); it is well-known to offer products with differing price schedules; and well-known to view price/order quantity on a web site. Applicants respectfully traverse the aforementioned well known statements and request that the Examiner cite a reference or references in support of this position pursuant to MPEP 2144.03 if the rejection of the claims is maintained. The Examiner is reminded that the standard for old and well-known concepts apply to the time of the invention. In other words, even if something is well-known today it may not have been well known at the time of invention and therefore inappropriate for use to reject claims. Moreover, the alleged old and well-known statements do not read upon the claimed subject matter in most if not all cases. For example, merely stating that Circuit City uses a customer's phone number to trace a consumer's history does not teach or suggest a *seller agent component* that utilizes historical data, but rather, simply phone number data.

Moreover, claim 18 recites, *the buyer agent component utilizes historical data to assist at least one of the plurality of buyers....* At page 12 of the Final Office Action, the Examiner incorrectly argues this is merely an intended use of the system. However, this assertion is also a mischaracterization because reciting capabilities of a component is not an intended use. In essence, the Examiner's analysis purports that the references disclose a buyer agent component, but a buyer agent component that cannot assist at least one of the plurality of buyers. Applicant's representative notes that if the buyer agent component of the Examiner's analysis cannot assist at least one of the plurality of buyers, then it is not the buyer agent component of the subject claims, irrespective of how either one is used or intended to be used. At page 12, the Examiner alleges that claim 17 is rendered obvious in view of Pallakoff because the reference could provide information of a production schedule. Assuming *arguendo* such is the case, Pallakoff still does not teach or suggest *the seller agent component determines a production schedule...* In particular, as found at page 5 of the Final Office Action, the Examiner regards both the seller agent component and the buyer agent component as terminals 12 and 14 of Pallakoff, respectively. Pallakoff does not teach or suggest that these terminals have any capabilities beyond displaying information to users. Hence, simple display terminals do not render obvious the subject components. That is, a terminal does not, *e.g.*, determine a production schedule, and as such does not read upon the instant claims.

With regard to claims 14, 16 and 19, Pallakoff fails to teach or suggest an agent component that *determines details that at least one of the plurality of sellers should include in an offer to achieve maximum profits and automatically creates an order for at least one of a plurality of products for at least one of the plurality of buyers* as recited in dependent claims 16 and 19 respectively. The Examiner contends that such claimed aspects are disclosed at col. 11, ll. 44-46, at Fig. 1, ref. 93, and at Fig. 3, ref. 37. Applicant's representative respectfully disagrees. The cited passage at col. 11, ll. 44-46 relates to allowing a buyer to express a conditional interest in a product. The cited figures relate to a system controller (*see* Fig. 1, ref. 93—although Fig. 1 does not contain ref. 93, Applicant's representative believes the Examiner intended to identify Fig. 1, ref. 13) and a methodology for accepting an offer (*see* Fig. 3, ref. 37). Thus, while Pallakoff discloses the ability to buy and sell products on the Internet and to express conditional product interest, nowhere does it disclose the distinct functionality to improve the



shopping process as recited by the subject claims. Accordingly, this rejection should be withdrawn.

Regarding claims 70 and 74, the logistics component facilitates ... “a cost savings for the product.” And claims 71 and 75 recite, the logistics component “applies the cost savings to the shipping price for the *subset of buyers*, however, for claim 72 (and potentially claim 75) the logistics component “applies the cost savings to a shipping price for *the plurality of buyers*.” Accordingly, it is readily apparent, *e.g.*, with respect to claim 72 that the cost savings for the product can be applied to *all* buyers of the product (*e.g.*, the plurality of buyers) rather than only for the buyers who share a particular shipping method (*e.g.*, subset of buyers). Thus, a first party can receive a cost savings for a product when other parties share a shipping method, even though the first party does not share a shipping method. None of the cited references or examples provided by the Examiner teach or suggest these features.

Finally, with regard to claims 73 and 76, the Examiner argues at page 12 that this is well-known because a “BIG box/package (from a store) with different sub-orders from several employees in an office” constitutes what is claimed. Applicant’s representative disagrees, as the Examiner tacitly ignores the claim language that “an order ... is independent from other orders received,” while describing a situation in which there is merely a single order aggregated beforehand by the buyer or several non-independent orders (*e.g.*, all from the same employer), which is tantamount to ignoring elements of the claims to support the rejection. Moreover, even if the Examiner’s example was germane and applicable to the subject claims, the Examiner’s ground for rejection is not. The Examiner states that “S/H cost can be easily divided among ordered people later on.” Assuming *arguendo* this is true, while the Examiner conjectures this could be done, no enabling references or other evidence of record have been provided to illustrate or support the stated proposition. That it could be done or would be easy to do is not dispositive of novelty or patentability.

In view of at least the foregoing, it is readily apparent (as the Examiner concedes) that Pallakoff is materially deficient to teach or suggest *a logistics component that determines a shipping price for the product ... the shipping price being determined based at least in part upon the subset of buyers sharing a shipping method*. Furthermore, both Shavit and the “delivery lunch” hypothetical are materially deficient as well. Rather, both Shavit and “delivery lunch,” at most, stand for the proposition that freight costs can be shared, which is not sufficient

to teach or suggest all the claimed features lacking from Pallakoff. Thus, the combination of Pallakoff with Shavit and/or “delivery lunch” does not teach or suggest every claim feature. Accordingly, this rejection of independent claims 1 and 43, as well as all claims that depend there from, should be withdrawn.

**CONCLUSION**

The subject application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [GEDP101USE].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant’s undersigned representative at the telephone number below.

Respectfully submitted,

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